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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/650,348  | 08/28/2003  | Daniel Ray Downing   | DN2001124D01        | 6674             |
| 27280   | 7590        | 11/02/2005           | EXAMINER            |                  |
| THE GOODYEAR TIRE & RUBBER COMPANY<br>INTELLECTUAL PROPERTY DEPARTMENT 823<br>1144 EAST MARKET STREET<br>AKRON, OH 44316-0001 |             |                      | GOODMAN, CHARLES    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3724                |                  |

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/650,348

Applicant(s)

DOWNING, DANIEL RAY

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 20-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. The Amendment filed on 8/24/05 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1, 2, 4-7, and 20-31 are rejected under 35 U.S.C. 102(a) as being anticipated by Benzing (WO 00/51810).

Benzing discloses a method of forming splice joints for elastomeric materials comprising all the steps claimed including, inter alia, moving a cutting device (e.g. 120) into cutting engagement of the elastomeric strip (1) while supporting the strip on an anvil (e.g. 108, 110); positioning the cutting edge of the cutting device at a gap distance (d) above the anvil slightly less than or equal to the thickness of the cord reinforced component (see p. 9, l. 29 - p. 10, l. 4); cutting the strip at a skive angle (e.g.  $\Theta$  in Fig. 5A); and impacting a cord, the impacting inherently occurs at times since neither the reference nor Applicant's invention teach or suggest a method or means that prevents any impacting to occur. See whole patent.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benzing (WO 00/51810) in view of Bell et al (US 5,265,508).

Benzing discloses the invention substantially as claimed except for the step of movably restraining the strip ahead of the cutting. However, Bell et al teaches the method step of movably restraining as claimed in the form of press rollers (36, 43 - e.g. Fig. 7) for the purpose of ensuring unwanted movement of the strip during the cutting operation. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the method of Benzing with the movably restraining step as taught and suggested by Bell et al in order to facilitate positive restraint of the strip from unwanted movement during the cutting operation.

### ***Response to Arguments***

6. Applicant's arguments filed 8/24/05 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Benzing does not anticipate the claimed invention because Benzing allegedly lacks certain limitations, these arguments are traversed.

First, it is not clear what Applicant is referring to when Applicant argues that Benzing does not position the cutting device at the claimed "slightly less than or equal to..." location when the teachings of Benzing are the same as Applicant. Note pp. 9-10 of Benzing as noted in the rejection. It is not clear how the placement of the cutting edge in Benzing, i.e. the depth, is different than that being claimed.

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Second, Applicant's assertions of the dual blades as well as cutting between cords in Benzing as somehow being patentably distinct from the claimed limitations are not persuasive. The dual blades in Benzing is not distinct from the claimed invention since the claims do not make such a distinction, i.e. none of the claims requires consideration of the number of blades. Cutting between the cords as taught by Benzing is not distinct from the claimed limitations of "impacting a cord" since in the prior art Benzing, the impacting inherently occurs during operation. The prior art Benzing does not teach any means or method that would prevent such impacting to occur and moreover, Applicant's own specification does not set forth how Applicant's invention would monitor such activity so that impacting would be assured. In other words, it is the Examiner's opinion that with respect to the "impacting" limitation, this is the preferred method and means of making the skive cuts in the elastomeric material, and on its face, it is not clear how Applicant's invention would always "impact" while making the cuts. Due to the lack of any monitoring means in Applicant's invention to insure impacting, is Applicant's invention patentable over Benzing when Applicant's invention inadvertently do not "impact" a cord? Furthermore, the mere statement by Applicant that the prior art Benzing cuts between cords is insufficient to overcome the obviousness or anticipatory nature of this limitation. Whether the inventions impact or do not impact the cord, the fact remains that in both instance the material is being cut between the cords.

In sum, it appears that factual proof may be necessary instead of or in addition to the arguments presented to show patentability of Applicant's invention.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (571) 272-4508. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (571) 272-4514. In lieu of mailing, it is encouraged that all formal responses be faxed to **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

cg

October 31, 2005



**Charles Goodman**  
**Primary Examiner**  
**AU 3724**

**CHARLES GOODMAN**  
**PRIMARY EXAMINER**